

Application No.: 10/848,929

Amendment and Response to 3/8/06 Office Action

AMENDMENTS TO THE DRAWINGS

Applicants acknowledge with appreciation that the drawings previously submitted did not mention character number 72 in Figure 1B. A replacement sheet for such drawing is submitted herewith with appropriate changes made thereto.

REMARKS

Summary of Examiner Interview

Applicants' counsel notes with appreciation the Examiner's brief interview on July 3, 2006 with respect to the present case. All claims were discussed. The Examiner and counsel agreed that a Terminal Disclaimer to U.S. Patent No. 6,846,178 appears appropriate to overcome the obviousness-type double patenting rejections. Applicants' counsel agreed to provide arguments to counter the obviousness rejection of all other claims and to submit a formal Amendment and Response with respect thereto.

Double Patenting Rejection of Claims 1-16 and Claims 1, 2, 4-7, 9-11 and 14-16

Applicants submit herewith a Terminal Disclaimer to the '178 patent in order to overcome rejections based on the judicially-created doctrine of obviousness-type double patenting. Applicants' counsel requests the courtesy of a telephone call from the Examiner if there are any questions or concerns with respect to such Terminal Disclaimer.

**Rejection of Claims 1, 2, 4, 6, 7, 9, 11, 12, 14 and 16 under 35 U.S.C. § 103(a)
as Being Unpatentable Over Franseen et al. in View of Andreiko et al. and JP 11-27650.**

The Examiner has rejected the above-referenced claims as being obvious in view of the combination of Franseen et al. in view of Andreiko et al. and JP 11-27650. Applicants respectfully traverse the Examiner's rejection of claims. The Examiner has previously allowed claims in U.S. Patent No. 6,846,178 entitled "Orthodontic Bracket Base Apparatus and Method of Manufacture." During such patent prosecution, the Franseen et al., Andreiko et al. and JP 11-276504 references were considered and cited on the face of the '178 patent. The Examiner admits that Franseen et al. do not disclose a base having a substantially continuous pattern of characters and intermediate space, including a discontinuous perimeter rail. Neither Andreiko et al. nor JP 11-276504 teach or suggest the present claimed embodiments, and the Examiner has not provided any reason or explanation why one of ordinary skill in the art, at the time of the present invention, would combine the novel

orthodontic bracket base with an orthodontic appliance such as that depicted in Franseen et al. Indeed, the Examiner's recitation of the purported purpose of combining Franseen et al. with Andreiko et al. and JP 11-276504 being "in order to increase the bond strength of the bracketing," is set forth in the '178 patent itself (i.e., see Claim 57 of '178 patent: "A method of improving the bonding strength of an orthodontic bracket . . .").

As the Examiner can see, the present claims essentially recite the novel features as set forth in the '178 patent and in addition, recite structural features from the orthodontic devices as described in the Franseen et al. '228 patent. In view of the Terminal Disclaimer submitted herewith, Applicants respectfully contend that there is no basis to reject the present claims because very similar claims were previously allowed by the same Examiner in the '178 patent prosecution. Indeed, because all three of the references presently relied upon by the Examiner (Franseen et al, Andreiko et al. and JP 11-276504) were considered in the '178 prosecution and because the present claims are narrower than those set forth in the '178 patent, the present claims must be considered non-obvious over the prior art.

For the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of the rejected claims.

Oath/Declaration

Applicants respectfully traverse the Examiner's concerns with respect to the previously submitted Declarations. As the Examiner can see, there is no dispute as to who the properly named inventors are on the present application and the apparent issue of the Examiner relates solely to the correction of a residence address for two of the inventors. Such amendments were made at the time the inventors executed the Declaration. This is not a violation of 37 C.F.R. §1.52(c). Such section is directed to interlineations or other alterations of application papers before the signing of any accompanying oath or declaration. The actual oath or declaration itself, however, if altered at the time of signing, does not fall within the preview of such rule. In any event, further indicia of the correctness of the named inventors is provided in the file, for example, in the assignment documents

of record and, most importantly, to the Amendment and Petition to Correct Inventorship submitted June 8, 2005. Each of the inventors provided their signatures again on April 5, 2005.

As a practical matter, the Examiner is informed that several of the inventors are no longer employed by assignee, Rocky Mountain Orthodontics, and thus, obtaining another Declaration (which Applicants again respectfully submit is unnecessary under the present circumstances) would be extremely difficult.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw any objections or concerns with respect to the submitted Declarations.

Objection to the Drawings

Applicants acknowledge with appreciation that the drawings previously submitted did not mention character number 72 in Figure 1B. A replacement sheet for such drawing is submitted herewith with appropriate changes made thereto.

Filing of Supplement Information Disclosure Statement

Submitted herewith is a Supplemental Information Disclosure Statement providing additional references for the Examiner's consideration.

New Claims

Applicants have set forth new claims in the present application and seek the favorable consideration thereof by the Examiner. Support for such claims can be found, for example, by reference to now issued U.S. Patent No. 6,846,178 (the parent application from which the present application is a continuation-in-part) and for which a Terminal Disclaimer is now presented, and in particular, the following claims of the '178 patent: Claims 1, 2, 3, 7, 11, 18, 29, 36, 48, 83, 90 and 91.

Applicants' counsel requests the courtesy of a telephone interview in the event the Examiner has any questions or concerns regarding this prosecution.

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Respectfully submitted,

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